

### **REMARKS**

The Office Action of November 28, 2005, has been considered by the Applicants. Claims 1, 12, and 17 have been amended. Claims 4, 5, 19, 28, 29, and 32-34 have been cancelled. Claims 1-3, 6-18, 20-27, 30, and 31 remain pending. Reconsideration of the Application is requested.

Claims 33 and 34 were objected to under 37 CFR 1.75(c). As these two claims have been cancelled, this objection is moot. Withdrawal of the objection is requested.

Claims 1, 3, 5-9, 14-18, 20-22, 24, 29, and 31 were rejected under 35 U.S.C. 102(b) as anticipated by Iwasaki (US 5,192,633).

Claims 1, 2, 4, 6-9, 14, 16-18, 20, 24, 25, and 28 were rejected under 35 U.S.C. 102(b) as anticipated by Mimura (US 5,008,173).

Claims 1, 3, 5-9, 14-18, 20, 29, and 31 were rejected under 35 U.S.C. 102(b) as anticipated by Grune (US 6,017,665).

Claims 1, 3, 5, 14-18, 20-22, 24, 25, 27, 29, and 31 were rejected under 35 U.S.C. 102(b) as anticipated by EP 1109068.

Claims 1, 3, 5-9, 15-18, 24, 25, 27, and 29-31 were rejected under 35 U.S.C. 102(b) as anticipated by EP 0823668.

Claims 1-9, 14-18, 27-29, and 31 were rejected under 35 U.S.C. 102(b) as anticipated by Mori (US 5,567,557).

Claims 1-9, 14-18, 20, 24, 25, 27-29, and 31 were rejected under 35 U.S.C. 102(b) as anticipated by Ueda (US 5,380,613).

Applicants traverse these rejections together.

The rejections variously show use of Irganox 565 and/or Irganox 1076 (which has the same chemical structure as Cyanox 2176) in the charge transport layer. Claim 1 has been amended to recite the presence of two charge transport layers, wherein the hindered phenol is present only in the second (outermost) charge

transport layer. Support for this limitation can be found in the specification in several places. In paragraph 0006 on page 2, an imaging member with two charge transport layers, wherein the hindered phenol is only in the second CTL, is described. The same imaging member is described from the bottom of page 6 to the top of page 7. The limitation is again described in paragraph 0014 on page 7. Finally, Examples II-IV have this limitation. None of the cited references teach this claim limitation and therefore they do not anticipate.

Claim 12 has been amended in light of the amendment to claim 1. Applicants take the position that claim 12 has been amended for clarification of its meaning and that its claim scope has not changed.

Similarly, claim 17 has been amended in light of the amendment to claim 1. Basis for the claim can be found in paragraph 0014 on the top of page 8.

Withdrawal of the 102(b) rejections is requested.

Claims 1-18 and 20-31 were rejected under 35 U.S.C. 103(a) as unpatentable over Yuh combined with Mori. Applicants traverse the rejection.

Not all claim limitations are taught. MPEP § 2143.03. As described above, Independent claim 1 has been amended to require two charge transport layers, wherein only the second CTL contains the recited antioxidants. Neither Yuh nor Mori teach an imaging member with two charge transport layers. Nor has the Examiner provided motivation from either of these references that would lead one skilled in the art to construct an imaging member having two CTLs. Therefore, the instant claims are not obvious over the combination of Yuh and Mori. Withdrawal of the § 103(a) rejection is requested.

Claims 1-9, 14-20, 24, 25, 27-29, 31, and 32-34 were rejected under 35 U.S.C. 103(a) as unpatentable over Totutake combined with Mori. Applicants traverse the rejection.

As the Examiner notes, Totutake teaches an imaging member containing two CTLs, wherein antioxidant is present in each CTL. The instant claims only contain antioxidant in the second CTL. Thus, the combination of Totutake and Mori does not

teach all claim limitations. There is no motivation in either reference to exclude antioxidant from only one of the CTLs. Therefore, the instant claims are not obvious over the combination of Totutake and Mori. Withdrawal of the § 103(a) rejection is requested.

### CONCLUSION

Applicants submit the pending claims (1-3, 6-18, 20-27, 30, and 31) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

It is believed that no fee is due in conjunction with this response. If, however, it is determined that fees are due, authorization is hereby given for deduction of those fees, other than the issue fees, from Deposit Account No. 24-0037.

Respectfully submitted,  
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